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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,113	12/07/2005	Harlan A Hurwitz	115572.03	2386

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EXAMINER	
SHAPIRO, JEFFERY A	

ART UNIT	PAPER NUMBER
3653	

MAIL DATE	DELIVERY MODE
07/22/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/524,113	HURWITZ ET AL.	
	Examiner	Art Unit	
	JEFFREY A. SHAPIRO	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/7/09 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 1, 16 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, taken as exemplary, recites a wherein clause in lines 15-17. It is unclear since some of the members of the group are either redundant or at odds with each other. For example, the term "retail store" is normally defined as a single store. However, the other members of the group seem to allude to inclusion of multiple stores

or kiosks. Since these members of the group appear at odds based upon their basic meanings, the group as a whole becomes unclear.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-7 and 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobbins (US 2002/0063034 A1) in view of Jones (US 6,128,402) and further in view of Ibarrola (US 5,368,149).

Regarding Claims 1, 16 and 19, Dobbins discloses the method and system of electronically managing a payment media exception processed from a payment media originating source, i.e., such as a cashier's cash drawer as mentioned at paragraph 3, first five lines, by a payment media handling apparatus, such as a bill acceptor (106), as mentioned in paragraph 32.

Dobbins further discloses Initiating a payment media acceptance operation using the payment media handling apparatus, i.e., such as mentioned in paragraphs 32 and 36, which mentions that cashiers who identify themselves or other persons with wireless ID tags, such as the store manager, may access the payment media handling apparatus.

Dobbins further discloses processing the at least one of the payment media determined to be unacceptable based upon instructions provided by a retail store. See

Dobbins at paragraph 49, last four lines, i.e., "many retailers require all $50 and $100 bills be dropped directly and immediately into the electronic safe..."

Dobbins does not expressly disclose, but Ibarrola discloses a step of accepting a coin of a face value in which the face value is limited to be less than a preset cash value at col. 6, lines 14-21.

Regarding Claims 1, 16 and 19, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have accepted currency face values beneath a preset limit, as taught by Ibarrola, in Dobbins' currency acceptor, since one ordinarily skilled in the art would have considered doing so for the predictable purpose of limiting the acceptance of larger size bills, as is customary in commerce.

Regarding Claims 2, 17 and 20, note that the originating source is the cash till of a register from a retail store.

Regarding Claims 3 and 18, note that Dobbins disclose handling bills and checks at paragraph 49.

Regarding Claim 4, note that Dobbins discloses reporting various parameters and data regarding the transactions with the payment media handling device at figure 4 and at paragraph 5, for example.

Regarding Claim 5, Dobbins discloses damaged or worn bills at paragraph 29.

Regarding Claims 1, 16 and 19, Dobbins does not expressly disclose, but Jones discloses automatically determining if the payment media is in an acceptable or unacceptable condition. See Jones at col. 8, lines 35-53.

Regarding Claims 1, 16 and 19, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have included a currency or bill acceptor as taught by Jones, in Dobbins' currency acceptor, since Dobbins' does not disclose details of such an acceptor, but suggests the use of an acceptor as taught by Jones. Further, Jones' device is disclosed at col. 3, lines 12-20 as rapidly processing bills. Thus, it would have been evident to one ordinarily skilled to incorporate Jones' bill acceptor into Dobbins' apparatus in order to rapidly process bills.

Regarding Claims 6-7, Jones further discloses notifying the user that the at least one payment media has been rejected by the currency handling device. See Jones at col. 8, lines 35-53, in which rejected bills are returned to the customer/user. Note that the act of returning the bills to the customer is construed as notification that the bills are unacceptable.

Regarding Claim 9, note that both Jones' and Dobbins currency handling devices are considered to be secure drop boxes.

Regarding Claim 10, note that Dobbins discloses placing payment media in an envelope at figure 2, for example.

Regarding Claims 11 and 12, Dobbins discloses providing information concerning the envelope of currency at paragraph 33.

Regarding Claim 13, see Dobbins again at paragraph 49, last four lines.

Regarding Claim 14, note again that Dobbins discloses processing envelopes only from approved users with a user id such as a wireless device as described at paragraph 35 and processing only particular values of bills at paragraph 49.

Regarding Claim 15, Dobbins discloses notifying a supervisor at paragraphs 36, 38 and 44-46.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dobbins (US 2002/0063034 A1) in view of Jones (US 6,128,402), further in view of Ibarrola (US 5,368,149), and still further in view of Jones (US 6,363,164 B1).

Dobbins discloses the system described above.

Regarding Claim 8, Dobbins does not expressly disclose, but Jones '164 discloses instructing the user to manually rearrange or reposition a portion of the currency that is determined to be unacceptable by the media handling apparatus, for the purpose of having the operator turn over reverse-faced bills that were unidentified and put them through the banknote validator a second time. See Jones at col. 63, lines 45-62 and col. 64, lines 55-63.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have instructed the user of Dobbins' currency acceptor to manually turn over reverse-faced bills and re-feed them through the bill validator, as taught by Jones, in Dobbins' currency acceptor, for the purpose of validating all bills in a stack, including those that are reverse-faced.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-20 of copending Application No. 10/524,109; Claims 1-19 and 21 of copending Application No. 10/524,110; Claims 1-19 and 24 of copending Application No. 10/524,111; Claims 1-18, 23 and 35 of copending Application No. 10/524,112; Claims 1-7, 9-10 and 12-14 of copending Application No. 10/933,289; and Claims 1-9, 11, 13-33, 35 and 37-45 of copending Application No. 11/117,563. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims of each of the mentioned applications embodies the subject matter of the Claims of the instant application. Specifically, these Claims recite a method of electronically managing a payment media exception processed from a payment media originating source by a payment media handling apparatus including the steps of initiating payment media acceptance using the payment media handling apparatus, automatically determining whether at least one of the payment media is in an unsuitable condition to be accepted by the media handling apparatus, and processing the at least one of the

payment media determined to be unsuitable based on rules in a lookup table, instructions from a user, instructions from a supervisor and instructions provided by an entity other than a retail store.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

9. Applicant's arguments with respect to Claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY A. SHAPIRO whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Shapiro/
Primary Examiner, Art Unit 3653

July 17, 2009